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08/933,500	09/18/1997	ROBERT FILEPP	1963-4727	6468

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EXAMINER

DINH, DUNG C

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/933,500

Applicant(s)

FILEPP ET AL.

Examiner

Dung Dinh

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2153

DETAILED ACTION

Response to Arguments

I. 35 USC § 101 Rejection of claim 33 over claim 1 of 5,758,072

In response to the 101 rejection of claim 33 over claim 1 of patent 5,758,072, Applicant stated that reliance on that claim was withdrawn; hence, whatever admission with respect to that claim is not viable. The response is not persuasive because Applicant has not rebutted the rejection, that is Applicant has not pointed out how claim 1 of '072 patent does not recite the same subject matter as claim 33 of the current application. Therefore, the 101 statutory double patenting rejection of claim 33 over claim 1 of patent 5,758,072 is maintained.

II. Obviousness type double patenting of claims 34-72 over claims 1 of patent 5,758,072.

The rejection is maintained for the same rationale as stated for the 101 statutory double patenting of claim 33 above.

III. Obviousness type double patenting of claims 33-34, 43-46, 47, 57-60, 62, 64-66, 67, 70-72 over claims 1-6 of patent 6,182,123.

Art Unit: 2153

Applicant offers to file a terminal disclaimer is acknowledged. The rejection stands as stated in the prior office action until a terminal disclaimer is file.

IV. 35 USC 112 rejection

A. Applicant argument is not persuasive with respect to the rejection of claims 35-36, 48-49, and 68-69 under 35 USC 112 1st paragraph for lack of support for the step of automatically connect the remote computer to the main computer after the selecting step and automatically disconnect after the variable is received.

B. Applicant argument is persuasive to overcome the rejection of claims 62-72 under 112 1st paragraph for lack of support for an "electronic catalog system".

Claims 35-36, 48-49, and 68-69 have been rejected under 35 USC 112 1st paragraph for lack of support for the step of automatically connect the remote computer to the main computer after the selecting step and automatically disconnect after the variable is received. Applicant argued that this feature is inherent in the type of distributed environment disclosed by applicant. Applicant asserted support for the feature by citing to a transaction logic that is automatically invoked to send and receive transaction data and then terminated execution.

Art Unit: 2153

Applicant implies that this indicates that a connection to the main computer is established when the logic is invoked and that connection is closed when the logic execution is terminated.

The argument is not persuasive because the automatic invoking and termination of the transaction logic does not follow that a connection is automatically established and then disconnected.

On the contrary, a connection could have been established ahead of time. The transaction logic could have make use of existing connection for sending and receiving the transaction data.

Applicant's submitted evidence filed 6/17/2003 - Exhibit 25 "A Summary Report on Founding Members Focus Groups" page 12 - supports this view. The report shows that a connection is established by the user and maintain throughout the session until the user logs off. The report identifies a wish for autologin. The report stated the founding members complained about the slowness of the process of logging on and off manually. Hence, the process of automatically connecting/disconnecting the remote computer to the main computer as recited in the claim is not inherent in the process of invoking/terminating the transaction logic as asserted by applicant. Furthermore, the specification must shown that applicant has possession of the invention.

Art Unit: 2153

"The purpose of the written description requirement is broader than to merely explain how to 'make and use'; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). That is, **the disclosure must show he had invented each feature that is included as a claim limitation**. The adequacy of the written description (i.e., the disclosure) is measured from the face of the application; the requirement is not satisfied if one of ordinary skill in the art must first make the patented invention before he can ascertain the claimed features of that invention. Cf. *Martin v. Mayer*, 823 F.2d 500, 505, 3 USPQ2d 1333, 1337 (Fed. Cir. 1987) ("It is not a question of whether one skilled in the art might be able to construct the patentee's device from the teachings of the disclosure [but] whether the application necessarily discloses that particular device." (quoting *Jepson v. Coleman*, 314 F.2d 533, 536, 136 USPQ 647, 649-50 (CCPA 1963))). *New Railhead Man. LLC v. Vermeer Man. Co.*, 63 USPQ2d 1843, 1847 (CA FC 2002) (emphasize added).

For the reason above, the 112 1st paragraph rejection of claims 35-36, 48-49, and 68-69 in the prior office action is maintained.

Claims 62-72 have been rejected under 112 1st paragraph because the specification does not disclose an "electronic catalog system". In view of the response and evidence submitted (Exhibit 25, pages 25-30) showing electronic catalog service for online shopping, the rejection is withdrawn.

V. 102 rejection of claim 1 of the '026 patent

The rejection is withdraw - claim 1 of '026 is not under examination. Applicant response on page 40 is persuasive that patentability of claim 1 of '026 is not relevant to the determination of 135(b).

VI. 35 U.S.C. 102(b) - public use/on-sale bar

A. On-sale bar

Applicant's response and the evidence submitted are persuasive to negate an on-sale bar.

A computer program product transferred to a customer is a transaction that is tantamount to a sale even though it is structured as a license restricting what the buyer does with the program. Group One, Ltd. v. Hallmark Cards, Inc., 59 USPQ2d 1121, 1130 (Fed. Cir. 2001, Louire, J., concurring).

The on sale-bar applies when, prior to the critical date, the product was 1) subject of a commercial offer for sale not primarily for purposes of experimentation and 2) ready for patenting. Allen Engr. Corp. v. Bartell Inds. Inc., 63 USPQ2d 1769, 1778 (CA FC 2002); Pfaff v. Wells Electronics Inc., 48 USPQ2d 1641, 1646-47 (1998).

"Experimentation negates a bar when the inventor tests claimed features of the invention." EZ Dock Inc. v. Schafer Systems Inc., 61 USPQ2d 1289, 1293 (CA FC 2002). "When an inventor can show changes during experimentation that result in features later claimed in the patent application, this evidence is a strong indication that the activities of the inventor

Art Unit: 2153

negated any evidence of premature commercial exploitation of an invention ready for patenting." Id.

Applicant claims priority to March 23, 1989 [paper #13 page 7]. The critical date therefore is March 23, 1988.

Claims 33 and 47 recite a method comprising essentially the steps of storing constant data and revision status at a remote computer and updating the constant data at the remote computer based on comparison of the revision status with that on a main computer. Claims 62 and 67 recite an electronic catalog system having means performing essentially the steps above. The method/system claimed operates primarily on data stored in a file named "stage.dat" on the remote computer. The usage of the stage.dat file exists as least as early as Nov. 1987 [Exhibit 21 page iii]. The evidence demonstrates that the software were distributed to customers at no charge with primary intention for testing the system [Exhibits 1-10, 23-25]. The customers were under a confidential, no disclosure agreement [Exhibit 23]. Exhibits 20 and 21 show that usage of the stage.dat file under went revisions up to at least March 1989.

The claimed invention was ready for patenting prior to the critical date. The claimed functions of retaining data and version checking of the retained data worked on the first release of the software, Nov. 1987. [Exhibit 21]. Later

Art Unit: 2153

modifications of these functions during the experimentation period are not recited in the claims. Hence, although the entire service was under experimentation, the claimed invention embodied by the stage.dat file is clearly ready for patent as early as Nov. 1987.

Exhibit 11 B, April 27, 1988, shows a plan to offer founding members six months free trial with renew membership at \$49.95 a year. It is well know business practice to entice customers with free trial in the hope that the customers will pay for the service after the trail period. Hence, the offer to the founding members is more of a commercial offer for sale than an experiment to test the claimed features of the present application. However, this does not arise to an on-sale bar because April 27, 1988 is after the critical date of March 23, 1988.

B. Public use

The present claims 33-71 are not barred under 35 USC 102(b) because it was not in public use prior to the critical date.

Applicant claims priority to March 23, 1989 [paper #13 page 7]. The critical date therefore is March 23, 1988.

Applicant demonstrated the Prodigy service at West Coast Computer Faire in San Francisco, California during the week of

Art Unit: 2153

April 7, 1988. (Response paper #13 p.11). Applicant asserted that this demonstration was experimental in nature - to gather information as to the desirability of the service and to expand the test user base. Applicant further asserted the demonstration did not reveal the limitation of the claims 33-72. (Response paper #13 p. 12).

"Public use" does not necessarily mean open and visible in the ordinary sense; it includes any use of the claimed invention by a person other than the inventor who is under obligation of secrecy to the inventor. *New Railhead Man. LLC v. Vermeer Man. Co.*, 63 USPQ2d 1843, 1848 (CA FC 2002). An invention exit for the purpose of statutory bar even though it may later be refined or improved. Id. Once an invention as claimed works for its intended purpose, further experimentation may constitute a barring public use. Id. at 1849.

The computer faire was open to the general public. Attendees observed the demonstration was not under any obligation of secrecy to Applicant. The faire was a 'live' demonstration of the PRODIGY Service. (See Exhibit 11 p.2). Applicant admitted that the demonstration used the reception software that was then in the field test. (Response paper#13 p.29). The claimed functionality of retaining objects on the remote computer is embodied by the usage of the 'stage.dat'

file. The 'stage.dat' file was functional as early as Nov. 1987. (See Exhibit 21 p.iii). The 'stage.dat' was modified in Dec. 1988 and March 1989. id. However, the added functions are not recited in the current claims.

Applicant asserted that the intended purpose the invention is to ensure the system function for large number of users. However, the current claims 33-72 do not recite any requirement of a large number of users. The claimed invention worked for its intended purpose as early as Nov. 1987 - that is to reduce data transmission by retaining certain objects on the remote computer and version checking to update the retained objects. Hence, even through the usage of the stage.dat file was not physical in public view at the computer faire, the demonstration used software with the stage.dat functionality in it; hence the demonstration at the computer faire constituted a public use of the claimed invention.

However, this public-use is not a bar under 35 USC 102(b) because the date of the demonstrations, April 7, 1988, is after the critical date of March 23, 1988.

VII. 35 USC 135(b)

Applicant's response is not persuasive to overcome the 35 USC 135(b) one-year statutory bar.

Art Unit: 2153

To establish entitlement to earlier effective date of existing claims for purposes of the one-year bar of 35 USC 135(b), Applicant must show that a later filed claim does not differ from an earlier claim in any material limitations; this is different question from whether claims made for purposes of interference are directed to the same or substantially the same subject matter. In re Berger, 279 F.3d 975, 982; 61 USPQ2d 1523 (Fed. Cir. 2002). A material limitation need not be expressed explicitly, but may be expressed inherently if the material limitation "necessarily results" from other limitations in the claim. Id. at 983 (citing Schutte, 244 F.2d at 326). The inquiry here is not whether such a step is inherently disclosed, but is whether the step necessarily occurs in the process as claimed. Id. (Citing Parks, 773 F.2d at 1580).

Applicant argued that the examiner must interpret the claim in view of the specification. (Response paper#13 page 43). The argument is not persuasive because this case is similar to that of Berger. The court in Berger held that Berger may not rely on the content of the specification and drawing to satisfy section 135(b). Id. Hence, citing the specification to support the limitations of the current claims is not proper. Applicant must show that the limitations of the current claims necessarily occur from the limitations of the prior claims. As stated in

Art Unit: 2153

the prior office action (paper #11 pages 26-28), the specific limitations recited in claim 33 do not necessarily occur from the limitations of prior claim 1. Therefore, the 135(b) rejection of claims 33-72 in the prior office action is maintained.

Conclusion

Claim 33 is rejected under 35 U.S.C. 101 as claiming same invention as that of claim 1 of prior U.S. patent 5,758,072 as stated in the prior office action (paper #11).

Claims 34-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent 5,758,072 as stated in the prior office action (paper #11).

Claims 33-34, 43-46, 47, 57-60, 62, 64-66, 67, 70-72 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. patent 6,182,123 as stated in the prior office action (paper #11).

Claims 35-36, 48-49, and 62-72 are rejected under 35 U.S.C. 112 first paragraph because the specification does not support the steps of automatically connect and disconnect after the variable data is receive as stated in the prior office action (paper #11).

Art Unit: 2153

Claims 33-72 are rejected under 35 U.S.C 135(b) as not being made prior to one year from which U.S. patent 5,528,490 (Hill '490) was granted as stated in the prior office action (paper #11).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

Art Unit: 2153

If attempts to reach the examiner by telephone **regarding this application only** are unsuccessful, contact the Special Programs Office, Josie A. Ballato at (703) 308-0269.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 2100 Customer Service whose telephone number is (703) 306-5631.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 746-7239, (for formal communications intended for entry)
(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).



Dung Dinh
Primary Examiner
September 21, 2003